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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,828	11/12/2003	Joseph P. Bigus	YOR920030510US1	8826

7590 12/29/2006	EXAMINER
Moser, Patterson & Sheridan Suite 100 595 Shrewsbury Avenue Shrewsbury, NJ 07702	CHEN, QING

	ART UNIT	PAPER NUMBER
	2191	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/29/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	10/712,828	BIGUS, JOSEPH P.
	Examiner	**Art Unit**	
	Qing Chen	2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *12 November 2003*.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-31* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1-31* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on *12 November 2003* is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All   b) ☐ Some * c) ☐ None of:
       1. ☐ Certified copies of the priority documents have been received.
       2. ☐ Certified copies of the priority documents have been received in Application No. _____.
       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20031112*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   This is the initial Office action based on the application filed on November 12, 2003.

2.   **Claims 1-31** are pending.

Drawings

3.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they

include the following reference character(s) not mentioned in the description:

- Reference numbers "1404," "1408," "1434," and "1436" in Figure 14.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the

specification to add the reference character(s) in the description in compliance with 37 CFR

1.121(b) are required in reply to the Office action to avoid abandonment of the application.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because

reference character "1412" has been used to designate both "I/O Controller" and "Keyboard."

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office

action to avoid abandonment of the application.

The drawings are objected to because:

- The word "editing" is misspelled in Element 720 in Figure 7.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office

action to avoid abandonment of the application.

Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the Examiner, the Applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4.   The abstract of the disclosure is objected to because:

- It contains a paragraph number.

- The first sentence is missing a verb. It should presumably read "An improved method for customization of rule-based applications, such as business process rules and policy is disclosed."

Correction is required. See MPEP § 608.01(b).

5.   The use of trademarks, such as JAVA, ILOG, FAIR ISAACS, and WEBSPHERE, has been noted in this application. Trademarks should be capitalized wherever they appear

(capitalize each letter OR accompany each trademark with an appropriate designation symbol,

e.g., ™ or ®) and be accompanied by the generic terminology (use trademarks as adjectives

modifying a descriptive noun, *e.g.*, "the JAVA programming language").

Although the use of trademarks is permissible in patent applications, the proprietary

nature of the marks should be respected and every effort made to prevent their use in any

manner, which might adversely affect their validity as trademarks.

Claim Objections

6.   **Claims 11 and 22-25** are objected to because of the following informalities:

- **Claim 11** is a duplicate of Claim 10. Applicant is advised to either amend or cancel

the claim.

- **Claims 22-25** contain a typographical error: a comma (,) should be added after the

parent claim number to separate the "further comprising" clause. Applicant is advised to

make the correction in order to keep the grammatical style of the claims consistent.

- **Claim 24** is a duplicate of Claim 23. Applicant is advised to either amend or cancel

the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

7.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8.   **Claims 14-31** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 14-25 contain "means-plus-function" limitations and appear to be systems. However, it is noted that the specification does not disclose any specific corresponding structure or equivalents thereof. The recited means appear to lack the necessary physical components (hardware) to constitute a machine or manufacture under § 101. Therefore, these claim limitations can be reasonably interpreted as computer program modules—software *per se*. The claims are directed to systems of functional descriptive material *per se*, and hence non-statutory.

The claims constitute computer programs representing computer listings *per se*. Such descriptions or expressions of the programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element, which defines structural and functional interrelationships between the computer program and the rest of the computer, that permits the

computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claims 26-31 recite a computer-readable media as a claimed element. However, it is noted that the specification describes such computer-readable media as embracing transmission media. Transmission media can take the form of acoustic or light waves, such as those generated during radio frequency (RF) and infrared (IR) data communications *(see Specification – Paragraph [00102])*. In addition, the specification also describes common forms of computer-readable media to include carrier wave *(see Specification – Paragraph [00102])*. Furthermore, the specification discloses that various forms of computer-readable media may be involved in <u>carrying</u> (emphasis added) one or more sequences of one or more instructions to CPU for execution *(see Specification – Paragraph [00103])*. This can be reasonably interpreted as computer-readable media carrying electrical signals.

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism *per se*, and as such are nonstatutory natural phenomena. *O'Reilly v. Morse*, 56 U.S. (15 How.) 62, 112-14 (1853). Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in § 101.

Claim Rejections - 35 USC § 102

9.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10.   **Claims 1-31** are rejected under 35 U.S.C. 102(e) as being anticipated by **Grindrod et al.**

(US 6,868,413).

As per **Claim 1**, Grindrod et al. disclose:

-     designating a customizable element of a set as a customizable template *(see Column*

8: 27-37, "Preferably for each condition, two expressions 242, 244 and a comparison operator

246 for comparing values of the two expressions as well as a logical operator 248 for allowing

grouping of conditions may be specified. The two expressions 240, 242 may be created by the

administrator using an expression builder ... "); and

-     compiling said customizable element into at least one object to form a ruleset *(see*

Column 14: 25-27, "... XML is generated from data regarding the new or modified business rule

as entered or modified via the user interfaces. "; Column 20: 50-53, "Examples of computer or

program code include machine code, as produced, for example, by a compiler, or files

containing higher level code that may be executed using an interpreter. ").

As per **Claim 2**, the rejection of **Claim 1** is incorporated; and <u>Grindrod et al.</u> further disclose:

- wherein said set comprises a ruleset *(see Figure 2; Column 7: 8-16, "The business rules management console 200 facilitates management of the business rules application and allows the administrator or end user to create and/or modify business rules in order to customize business processes. ")*.

As per **Claim 3**, the rejection of **Claim 1** is incorporated; and <u>Grindrod et al.</u> further disclose:

- parsing said set to detect said customizable element designated as a customizable template *(see Column 8: 44-46, "The business logic application preferably processes each condition line by line beginning with the first condition specified in the user interface 230. ")*.

As per **Claim 4**, the rejection of **Claim 1** is incorporated; and <u>Grindrod et al.</u> further disclose:

- customizing said element *(see Column 11: 41-48, "The following are examples of expressions in which symbols are designated with braces characters {}. Examples of expressions include: Hello, the time is {TIME}. The Help Desk Ticket {TR, Problem No.} was created in response to your request on {DATE} at {TIME}. {DB, Clients, Client ID, "Sequence"=1221} ... ")*.

As per **Claim 5**, the rejection of **Claim 1** is incorporated; and <u>Grindrod et al.</u> further

disclose:

- wherein said element comprises a variable *(see Column 11: 49-55, "... symbols may*

represent various types of data such as ... system environmental variables ...").

As per **Claim 6**, the rejection of **Claim 1** is incorporated; and <u>Grindrod et al.</u> further

disclose:

- wherein said element comprises a rule *(see Column 11: 49-55, "... symbols may*

represent various types of data such as ... business rules templates ...").

As per **Claim 7**, the rejection of **Claim 1** is incorporated; and <u>Grindrod et al.</u> further

disclose:

- wherein said element comprises a ruleset *(see Column 11: 49-55, "... symbols may*

represent various types of data such as ... business rules templates ...").

As per **Claim 8**, the rejection of **Claim 1** is incorporated; and <u>Grindrod et al.</u> further

disclose:

- designating a ruleset of said set as a customizable ruleset template *(see Column 12:*

41-44, "Preferably, business rules templates are provided. Business rules templates are

predefined and reusable text items that can be defined, stored, and reused by various business

rules.").

As per **Claim 9**, the rejection of **Claim 8** is incorporated; and <u>Grindrod et al.</u> further disclose:

- generating a customized ruleset from the customizable ruleset template *(see Column 12: 41-44, "Preferably, business rules templates are provided. Business rules templates are predefined and reusable text items that can be defined, stored, and reused by various business rules." and 48-49, "Templates allow the same string of text to be re-used by multiple business rules.").*

As per **Claim 10**, the rejection of **Claim 1** is incorporated; and <u>Grindrod et al.</u> further disclose:

- enabling customization in a deployment environment *(see Column 7: 39-44, "In particular, FIGS. 3-6 are exemplary user interfaces 220, 230, 250, and 270 for entering or modifying and displaying general information, conditions, actions, and schedule, respectively, regarding a new business rule or an existing business rule selected via, for example, the business rules manager.").*

Claim 11 is rejected for the same reason set forth in the rejection of Claim 10.

As per **Claim 12**, the rejection of **Claim 1** is incorporated; and <u>Grindrod et al.</u> further disclose:

- re-editing a previously generated rule *(see Column 7: 30-32, "From the business rules management console 200, the administrator may elect to create, modify, or delete a business logic rule.").*

As per **Claim 13**, the rejection of **Claim 1** is incorporated; and <u>Grindrod et al.</u> further disclose:

- wherein a new ruleset is generated from a customizable ruleset template, and a pre-existing customizable rule template is associated with said new ruleset and is unchanged *(see Column 12: 41-44, "Preferably, business rules templates are provided. Business rules templates are predefined and reusable text items that can be defined, stored, and reused by various business rules." and 48-49, "Templates allow the same string of text to be re-used by multiple business rules.").*

Claims 14-25 are system claims corresponding to the method claims above (Claims 1-12) and, therefore, are rejected for the same reasons set forth in the rejections of Claims 1-12.

Claims 26-31 are computer-readable media claims corresponding to the method claims above (Claims 1-4, 8, and 9) and, therefore, are rejected for the same reasons set forth in the rejections of Claims 1-4, 8, and 9.

Conclusion

11.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. **Ono** **(US 5,084,813)** discloses a technique of selectively and automatically

synthesizing a program suitable for a target system upon input of a system specification of the

target system to be controlled by the automatically synthesized program.

B. **Martin et al.** **(US 5,450,545)** disclose a method and system for generating a rules-

based computer program employs an interactive workstation to display input data format screens.

C. **Morris et al.** **(US 5,500,802)** disclose a system that employs templates for allowing

user-supplied definition of a given product or service.

D. **Gross et al.** **(US 5,555,346)** disclose a rule based system and rule editor for

manipulating messages in the electronic mail messaging system.

E. **Joshi et al.** **(US 5,812,847)** disclose a method for designing graphic user interfaces

(GUI) based on rules.

F. **Buxton et al.** **(US 5,978,579)** disclose a component customization and distribution

system in an object-oriented environment provides a template builder utility, which enables a

base component to be selectively modified and the modifications to the base component stored as

a template.

G. **Buxton et al.** **(US 6,093,215)** disclose a component customization and distribution

system in an object-oriented environment provides a template builder utility, which enables a

base component to be selectively modified and the modifications to the base component stored as

a template.

H. **Branson et al.** **(US 6,513,152)** disclose an object oriented framework mechanism for

customization of object-oriented frameworks provides an infrastructure that embodies the steps

necessary to customize a selected object oriented framework (referred to herein as an "input framework").

I. **Challenger et al.** (US 6,725,265) disclose a method and system for caching customized information in a network-server system.

J. **Zothner** (US 6,745,382) discloses creating a simple user-friendly interface to CORBA objects, which allows an exception to occur without disrupting a transaction within a business rules engine.

K. **Zielinski et al.** (US 6,883,144) disclose a system and user interface supporting multiple different executable applications employing user customizable expressions for determining computable values or searching for records, for example.

L. **Bigus et al.** (US 7,136,843) disclose a single rule language supporting a plurality of rulesets, an object-oriented framework that compiles the rulesets into a collection of framework objects, and a plurality of pluggable inference engines for processing the collection of framework objects.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Qing Chen whose telephone number is 571-270-1071. The Examiner can normally be reached on Monday through Thursday from 7:30 AM to 4:00 PM. The Examiner can also be reached on alternate Fridays.

· If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Wei Zhen, can be reached on 571-272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the TC 2100 Group receptionist whose telephone number is 571-272-2100.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WEI ZHEN
SUPERVISORY PATENT EXAMINER

QC / *QC*
December 11, 2006